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IN THE

Supreme Court of the United States

October Term, 1971

No. 71-1499

DEVCON CORPORATION,
Petitioner,

v.

WOODHILL CHEMICAL SALES CORPORATION,
Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT

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May 15, 1972

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v.

WOODHILL CHEMICAL SALES CORPORATION,
Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT

The petitioner Devcon Corporation respectfully prays that a writ of certiorari issue to review the judgment and opinion of the United States Court of Appeals for the First Circuit, entered on March 20, 1972, vacating a preliminary injunction against respondent.

Opinions Below

The opinions of the Court of Appeals, staying the preliminary injunction on January 20, 1972, reported at 172 U. S. P. Q. 417, and vacating the injunction on March 20, 1972, not yet reported, appear in the Appendix hereto.

The preliminary injunction of the District Court for the District of Massachusetts ordered on January 6, 1972, by Caffrey, Ch. J., and the memorandum recommending the granting of the preliminary injunction, dated December 28, 1971, by Davis, M., not reported, also appear in the Appendix.

Jurisdiction

The judgment of the Court of Appeals was entered on March 20, 1972, and this petition is being filed within 90 days of that date. This Court's jurisdiction is invoked under 28 U. S. C. § 1254(1).

Questions Presented

1. Whether a decision of a magistrate based in pertinent part upon oral-testimony evidence and set forth by a district judge as the grounds for issuance of a preliminary injunction can be set aside by a court of appeals without reaching the propriety of the magistrate's findings.

2. Whether words defining a period of time are, as a trademark, merely descriptive of goods which comprehend said period in use where because of many variables an understanding of the period requires perception and imagination.

3. Whether a latecomer intentionally employing the words of a registered trademark falsely to describe his product should be preliminarily enjoined.

Statutory Provisions Involved

United States Code, Title 28:

§ 636 *Jurisdiction and powers*

* * *

(b) Any district court of the United States, by the concurrence of a majority of all the judges of such district court, may establish rules pursuant to

which any full-time United States magistrate, or, where there is no full-time magistrate reasonably available, any part-time magistrate specially designated by the court, may be assigned within the territorial jurisdiction of such court such additional duties as are not inconsistent with the Constitution and laws of the United States. The additional duties authorized by rule may include, but are not restricted to—

* * *

(2) assistance to a district judge in the conduct of pretrial or discovery proceedings in civil or criminal actions;

United States Code, Title 15

§ 1052. *Trade-marks registrable on principal register; concurrent registration*

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

* * *

(e) Consists of a mark which, (1) when applied to the goods of the applicant is merely descriptive or deceptively misdescriptive of them . . .

Statement of the Case

In 1967, Devcon Corp., the petitioner herein, a supplier of industrial adhesives, completed development of an epoxy adhesive, and introduced the new product under the trademark "5 MINUTE". The first fast-setting retail *epoxy*—the strongest of adhesives—"5 MINUTE" was an instant success. The immediate demand was so great and unexpected that Devcon for several months was unable to meet it. Sales increased monthly until 1971. "5 MINUTE" opened the retail market for Devcon and is now Devcon's most important consumer product. R. [1st Cir. printed Appendix] 8, 13, 494, 551.

Also in 1967, Woodhill Chemical Sales Corp., respondent herein, introduced a fast-setting retail epoxy bearing the trademark E·POX·E QUICK-SET. In 1969, Woodhill conducted market surveys which demonstrated a considerable "need" for a quick-setting epoxy, which E·POX·E QUICK-SET was not meeting, and that 90 percent of the respondees favored Woodhill's introduction of a "1-5 minute epoxy". R. 109-12, 312, 337, 340.

Woodhill had been aware of Devcon's "5 MINUTE" since its introduction in 1967. After the surveys, Woodhill in 1970 decided to introduce another fast-setting epoxy and to use the term "five-minute" to promote it. R. 93-94. Woodhill had had previous contact with Hardman, Inc., a supplier to retail distributors of adhesives, among them its fast-setting epoxy designated EPOWELD. R. 348-54.

Devcon occasionally advertised the setting or hardening time of "5 MINUTE" as "5 minutes". For three years, until 1970, at least, no other company used the words in advertising. R. 554. Woodhill never advertised the setting or hardening time of QUICK-FIX. Hardman specified the setting time of EPOWELD in a technical bulletin which Woodhill had seen, as "just 3 to 4 minutes". Woodhill's chemist tested EPOWELD and reported that it did not harden in five minutes. R. 330, 329.

In late 1970, Woodhill introduced its new fast-setting epoxy as E·POX·E 5 FIVE-MINUTE GLUE. It is EPOWELD supplied by Hardman and repackaged by Woodhill. It comes in two packages, and the term FIVE-MINUTE is used six times on one and ten times on the other. 2d Supp. App. 2-5.

In April, 1971, Devcon sued Woodhill for infringement of its trademark, then registered, and also for unfair competition. Depositions of Woodhill and Hardman employees were taken, and the instant motion for preliminary injunction was brought on November 12. The case was assigned to Magistrate Willie J. Davis, who heard the motion on December 21. At the hearing, uncontradicted oral testimony described a typical use of "5 MINUTE" by "the average consumer". R. 497-99; *infra* pp. 7-8. This testimony demonstrated that because of many variables in the use of the product, "5 MINUTE" would not be seen by the average consumer as descriptive but only suggestive.

On December 28, the magistrate, concluding not only that the mark "5 MINUTE" was suggestive but also that secondary meaning could "very well" have been acquired, submitted his Memorandum to Chief District Judge Caffrey, recommending the grant of the motion. On January 6, 1972, the district judge, setting forth the magistrate's memorandum, granted the motion enjoining trademark infringement and any promotional use of "5 MINUTE" or any portion or modification thereof. Appendix pp. 19-26, *infra*.

On January 11, an appeal was brought by respondent in the court of appeals, and after a brief hearing before Chief Judge Aldrich, the injunction was stayed. The appeal was argued on March 6 and judgment was entered vacating the injunction on March 20. The court of appeals set aside the magistrate's memorandum and vacated the injunction solely on unstated "conceded facts" and its "own conclusion as to the probability of [petitioner's] success". Appendix pp. 14-19, *infra*.

REASONS FOR GRANTING THE WRIT

This is an uncomplicated case which presents to the Court for the first time two questions of widespread significance. The first question is procedural and turns on the weight to be given on appeal to a magistrate's findings adopted by a district judge in a pretrial order. The second question is substantive, relating at once to both: (a) the validity of a time-period trademark, *viz.* "5 MINUTE", which the First Circuit deems descriptive rather than suggestive, in conflict with decisions of the Patent Office and the Court of Customs and Patent Appeals; and (b) a latecomer's rights to employ the words of a trademark, with respect to which the First Circuit's decision conflicts with the reasoning of the second, third, seventh and ninth circuits. The decision below vitiates by its reasoning many other time-period trademark registrations.

1. The decision below raises significant and recurring problems concerning the authority of magistrates to hear motions and the weight to be given their findings.

The First Circuit's opinion in this case invalidates the assistance given the district judge by the magistrate who heard the instant motion and evaluated in a comprehensive memorandum the testimony and other evidence presented at hearing. The court of appeal's action was abrupt if not capricious. Within the hour of appeal a hearing before Chief Judge Aldrich on Woodhill's motion to stay was granted (and delayed a few minutes to permit a reading of the order and the magistrate's memorandum).

At the hearing the judge manifested his own beliefs that the matter should not have been heard—much less decided—by the magistrate and that the magistrate's resolution of the evidence was naive and incomprehensible. Judge Aldrich,

professing expertise in the epoxy field, argued that the period "five minutes" must be comprehended by the curing process[1]; hence, he viewed "5 MINUTE" as a descriptive mark for a fast-setting epoxy and could not conceive of a consumer viewing it otherwise.

But the magistrate had found otherwise. At the hearing before him, several hundred pages of deposition testimony and exhibits were presented, and oral testimony was heard, including the following (R. 497-99):

> "Q. Can you tell us how you use it? Give us an example of how you might use it or how one might use it, the average consumer? A. Well, one favorite use is to glue stones together as a hobby to make ducks or decoys. I simply have 2 stones, one like a duck head, and you mix the two materials together thoroughly; and after a while you would simply take the head of the duck and touch it to the "5 minute" and hold it on top of the body and hold it there for another 2 or 3 minutes, and then finally let it go, and it is a stationary finished piece.
>
> "Q. Well, can you estimate how long it takes you to mix the product? A. I would mix it for a minute or 3 minutes. Something of that sort. I mix it well to be sure it is well mixed.
>
> "Q. And then I assume you immediately apply it and it takes how long, another minute? A. I wouldn't necessarily apply it right away. I might or I might dip the head in it.
>
> "Q. And then you hold it? A. And hold it there for a minute.
>
> "Q. Until you are pretty sure it is not going to fall apart? A. So it won't collapse, right.
>
> "Q. Have you ever used the product to bond a weighty object up against a vertical surface like a wall? A. Yes, I have.

[1] It had been stipulated that the Devcon product "set" in five minutes. The Woodhill product, on the other hand, as described by its formulator's specification sheets, set in "just 3 to 4 minutes". See R. 330, 500-01.

"Q. Would you have to hold it longer in that case? A. Yes, I would say so.

"Q. Why is that? A. Well, if it is under tension or under a weight, it would take longer to harden. If it is on a flat surface like the duck's head on top of the duck's body, it doesn't take quite as long. It isn't exact.

"Q. Let's assume we take the table, and let's assume that the bottom of the 4 legs is flat, and let's assume we want to glue it up to the wall here. Do you think "5 Minute" could do that? A. Yes, it could.

"Q. How long would you have to hold it up there? A. I would want to hold it up there for about 10 minutes anyway.

"Q. Are you sure it wouldn't fall down? A. It may, I don't know.

"Q. Would it be less likely to fall down if you held it up there for an hour? A. Yes."

No cross-examination was taken, and the above testimony stands uncontradicted. The magistrate plainly relied on this testimony in concluding that the mark "5 MINUTE" is suggestive and not descriptive, by stating "there are too many variables involved which would preclude one from seeing that five minutes describes the product." Appendix p. 25, *infra*.

None of this evidence had been presented to Judge Aldrich; it was, simply, not possible to do so.[2] All he saw was an illusory collection of epoxy products, selected by Woodhill's counsel from physical exhibits not in evidence, which tended to show widespread infringement by others but which, as the magistrate correctly saw (see Appendix p. 24, *infra*), did not excuse Woodhill. See also, *e.g.*, R. 425-32. Seeing no danger of immediate, irreparable harm, Judge Aldrich concluded the hearing by staying the injunction.

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[2] The transcript of the magistrate's hearing had not been prepared, and the record was in transit somewhere between the two clerks' offices.

The full court upheld Judge Aldrich, criticized the district judge for assigning "such an important matter" to be heard by only a magistrate, and implied error by the district judge both in having the magistrate draft the injunction and in issuing the injunction without opportunity for further hearing. Appendix pp. 14-15, *infra*.

The important point here is not whether the circuit court or the magistrate is correct, but—far broader—whether factual findings of magistrates charged to assist district judges in pretrial matters are to be given the presumption accorded the trier of fact under federal procedure.

The First Circuit gave no weight to the magistrate's findings. And, after having challenged the procedure of the district court and having reserved discussion of it, the court refused to reach its propriety—a result that leaves the status of magistrates so chaotic as to call for an exercise of this Court's power of supervision. The court left no doubt about its contempt for the magistrate's actions and its disregard of his findings:

> "Our discussion of the magistrate's resolution of the evidence is without prejudice to the broad issue of its propriety, which we do not reach. We decide this case on the conceded facts, and our own conclusion as to the probability of plaintiff's success."

The circuit court's procedure was in direct conflict with its own decisions relating to preliminary injunctions (*Automatic Radio Mfg. Co.* v. *Ford Motor Co.*, 390 F. 2d 113; *Engine Specialities, Inc.* v. *Bombardier Ltd.*, 454 F. 2d 527); and to weight of district court findings (*Celebrity, Inc.* v. *Trina, Inc.*, 264 F. 2d 956). It was contrary to Rule 52(a), Fed. R. Civ. P., since the district judge had "set forth" the magistrate's memorandum as the grounds of this action.

We have stressed the arbitrary procedure followed by the circuit court because it is so clearly a less satisfactory jurisprudential process than that followed in the district court. The facts should be decided by the judicial officer who hears testimony and receives evidence. *Morgan* v. *United States*, 298 U. S. 468, 481.

No better illustration of the wisdom of this rule exists, in our view, than a fundamental error here of the circuit court in confusing witnesses. Judge Aldrich's primary factual statement was that Devcon's "own witnesses testified that their initial intent was to find an epoxy glue that set in five minutes." But the testimony by Devcon's president—who appeared before the magistrate—contradicts this finding.[3] The only testimony of such intent is that of Mr. Gelb, testifying about *Woodhill's* intent, not *Devcon's*, at R. 89.[4]

Facts should not be resolved in the circuit courts. There are compelling reasons why magistrates should be employed more—not less—in pretrial matters. But they will not if their findings are without the presumptions due the trial court. The refusal of the First Circuit to respect the magistrate's action and findings cannot be justified.

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[3] By Mr. Creighton: A. " . . . [We] were looking for a fast material . . . During the early stages we would have been very happy to have gotten something that was twice that time [five minutes] or three times that time." R. 220.

[4] We cited Gelb's testimony presuming that the circuit court would know he was president of *Woodhill*, with first-hand knowledge of Woodhill's intention to infringe. We presumed too much, for Judge Aldrich thought Gelb, who was our *witness*, to be our president as well, testifying about Devcon's intent.

2. The decision below is in direct conflict with decisions of the Court of Customs and Patent Appeals and the Patent Office and vitiates countless other like trademarks.

This court has granted certiorari to resolve a "running" conflict between the Patent Office and the Court of Customs and Patent Appeals, or between the CCPA and a circuit court. *Brenner* v. *Manson,* 383 U. S. 519, 522 n. 4. Here, there are direct conflicts between the First Circuit and the CCPA and between the First Circuit and a running line of trademark registrations issued by the Patent Office. The effect of the decision below is to vitiate *all* of these registrations, even those that have become incontestable, or have acquired exclusive rights, pursuant to 15 U. S. C. §§ 1065, 1115(b).

The First Circuit acknowledged that *In re One Minute Washer Co.,* 25 C. C. P. A. (Pat.) 978, 95 F. 2d 517, presented a "reverse" case. Actually, it can be viewed either of two ways, each of which presents direct conflict. First, the trademark ONE MINUTE can be viewed as suggesting the period (*viz.,* the washer loading time) comprehended by the product's operation but less than the full operating time (7-11 minutes). Or, the time "one minute" can be viewed as arbitrary and unrelated to the product. In the first view the issue was whether the mark was descriptive; in the other, whether it was *mis*descriptive. See 15 U. S. C. § 1052(e). The first view is parallel to the case here: "5 MINUTE" suggests the setting time of the Devcon epoxy (five minutes) which is comprehended in the overall curing process (taking about an hour; R. 388, 391). The other view is the reverse, as the circuit court recognized. By either view, a direct conflict results.

The CCPA held ONE MINUTE to be registrable because an understanding of "the meaning intended to be conveyed by [the] mark" required the "exercise . . . of perception and imagination"—a classic statement of the suggestive doctrine. See also, *e.g.*, *Stix Prods., Inc.* v. *United Merchants & Mfrs., Inc.*, 295 F. Supp. 479, 488 (S. D. N. Y. 1968); Martin, "The Meaning of Distinctiveness in Trade-Mark Law", 45 Ill. L. Rev. 535, 539 (1950).

Since the *One Minute* decision the Patent Office has consistently issued trademark registrations for time-period marks,[5] twenty-three others in the record—seven for 5 MINUTE or FIVE MINUTE alone. See R. 524-25. Presumably, most if not all of these registrations are for goods which in use comprehend the suggested time period. All such registrations, under the reasoning below, are defenseless. MINUTE rice (Reg. No. 807,347; 2d Supp. App. 26), for example, could be infringed with impunity because in First Circuit logic any restraint on the use of the word "minute" would compel competitors "to water down" their products. See Appendix p. 18, *infra*. The First Circuit upholds a latecomer's freedom of speech in conflict with the equitable reasoning of other circuits.[6]

[5] The Circuit Court failed to see the vital distinction between a time period *per se* (e.g., "5 MINUTE") and a time period coupled with a verbal (e.g., "10-Second Set"); *compare In re Songrand Corp.*, 168 U. S. P. Q. 669 (T. T. & A. B. 1970).

[6] The defendant in a case decided by way of summary judgment in the second circuit had a better argument, in our view, where the arguably descriptive word HYGIENIC was being used on mattress covers in infringement of the registered mark HYGIENT. *Venetianaire Corp.* v. *A & P Import Co.*, 302 F. Supp. 156 (S. D. N. Y. 1969); *aff'd* 429 F. 2d 1079 (2d Cir. 1970).

E.g., Harold F. Ritchie, Inc. v. *Chesebrough-Ponds, Inc.*, 281 F. 2d 755, 758-59 (2d Cir. 1960); *Q-Tips, Inc.* v. *Johnson & Johnson*, 206 F. 2d 144, 147 (3d Cir. 1953); *G. D. Searle & Co.* v. *Chas. Pfizer & Co.*, 265 F. 2d 385, 386-87 (7th Cir. 1959); *Audio Fidelity, Inc.* v. *High Fidelity Recordings, Inc.*, 283 F. 2d 551, 558 (9th Cir. 1960).

These conflicts regarding the suggestive trademark doctrine justify the grant of certiorari to review the judgment below. It is time for this Court to accept a case dealing with this important doctrine in order that uniform standards may be established. The bulk of trademarks in commerce are suggestive of their goods. Standards of validity need definition; scope of enforceability requires delineation.

Finally, as a basis for reversal, we submit that a latecomer who intentionally uses the words of a registered trademark falsely to describe his product should be preliminarily enjoined. *Cf. e.g., My-T-Fine Corp.* v. *Samuels*, 69 F. 2d 76, 77 (2d Cir., L. Hand, J.).

Conclusion

For these reasons, a writ of certiorari should issue to review the judgment and opinions of the First Circuit.

Respectfully submitted,

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Counsel for Petitioner.

May 15, 1972.

APPENDIX

UNITED STATES COURT OF APPEALS
FOR THE FIRST CIRCUIT

No. 72-1011

DEVCON CORPORATION,
Plaintiff, Appellee,

v.

WOODHILL CHEMICAL SALES CORPORATION
et al,
Defendants, Appellants.

APPEAL FROM THE UNITED STATES DISTRICT COURT FOR THE DISTRICT OF MASSACHUSETTS ON APPLICATION FOR STAY PENDING APPEAL.

Before ALDRICH, *Chief Judge,*
MCENTEE and COFFIN, *Circuit Judges.*

H. D. Cooper, with whom *Howard L. Weinshenker, Yont and Tarolli, Stanley Sacks,* and *Wolf, Greenfield & Sachs* were on petition for stay and memorandum in support thereof.

Douglas E. Whitney, with whom *Russell & Nields* was on memorandum in opposition to appellant's petition for stay.

January 20, 1972

PER CURIAM. We have before us a motion to stay, pending appeal, a preliminary injunction granted against asserted trademark infringement. Except to say that it raises grave doubts, we will reserve until a later date discussing a procedure under which the only hearing given the defendant on such an important matter was before a magistrate. The magistrate wrote an opinion in which he found that there is a great likelihood of consumer confusion between the products of the plaintiff and defendant; that

plaintiff's mark is not descriptive but suggestive, and that plaintiff would suffer irreparable harm, without immediate relief, because its mark could be destroyed. If typewriting is a guide, the magistrate prepared the broad injunction for the district judge to sign. This he did without notice or opportunity to be heard.

Both parties make an epoxy glue of, so far as appears, substantially identical use characteristics. Its attraction is two-fold—great strength, and fast setting. The exact setting time depends upon the temperature, but it appears that at normal room temperature the time is approximately five minutes. Plaintiff received a registered trademark "5 MINUTE," which it uses in connection with the word Epoxy. Defendant calls its product "E-POX-E 5," and adds on its retail cards to which the individual tubes are attached, in considerably smaller print, "Five Minute Glue."

According to the magistrate's findings, in 1967 plaintiff "was successful in developing a glue which sets in five minutes," and was the only manufacturer of "epoxy which sets in five minutes" for three years. Plaintiff's president testified by deposition that he called his product "5 Minute" epoxy because "[w]e're trying to give the customer an idea that it sets up in about five minutes' time." He testified that his product "hardens," "does set up" and "sets" in "about five minutes." On the back of plaintiff's package is the notation that the product "will harden in approximately five minutes." We are at a loss to understand the magistrate's conclusion of non-descriptive in the light of this evidence. If the product does not, in fact, set in the advertised five minutes, the mark would appear to be misdescriptive. Either is normally forbidden. 15 U. S. C. § 1052(e).* The

* Understandably, the magistrate did not make the finding that plaintiff appeared to have satisfied the heavy burden of showing itself within section 1052(f).

case seems the reverse of plaintiff's case of *In re One Minute Washer Co.*, (Ct. of Cus. & Pat. App., 1938) 95 F. 2d 517.

We are deeply troubled to think that a party can seize upon one of the primary characteristics that makes an unpatented commercial product marketable and preempt or limit competitor reference by registering it as a trademark. The thrust of plaintiff's position is illustrated by its counsel's response to our question. He "personally" (the word was his) thought it was all right if defendant said in small letters on the back of the card that its glue sets in five minutes, so long as it did not say so in large letters on the front.

Plaintiff concedes that its only claim for irreparable damage is the possibility that, *pendente lite*, its mark could be destroyed. We realize that there are famous instances of destruction by general use. *See, e.g., Bayer Co.* v. *United Drug Co.*, S. D. N. Y., 1921, 272 F. 505. *See also DuPont Cellophane Co.* v. *Waxed Products Co.*, 2 Cir., 1936, 85 F. 2d 75, *cert. denied* 299 U. S. 601. Plaintiff offers no case suggesting that this could occur during the relatively short interval in which a case was being tried. In explanation, plaintiff says that the case at bar is *"sui generis."* If this be so it could only be because plaintiff wants its product to be the only one known as setting in five minutes—precisely what we doubt its right to.

Defendant has fully met its burden. The court orders the stay of the preliminary injunction granted at the hearing before the single judge continued until disposition of the appeal.

UNITED STATES COURT OF APPEALS

FOR THE FIRST CIRCUIT

No. 72-1011

DEVCON CORPORATION,

Plaintiff, Appellee,

v.

WOODHILL CHEMICAL SALES CORPORATION *et al,*

Defendants, Appellants.

APPEAL FROM THE UNITED STATES DISTRICT COURT FOR THE DISTRICT OF MASSACHUSETTS

Before ALDRICH, *Chief Judge,*
McENTEE and COFFIN, *Circuit Judges.*

H. D. Cooper, with whom *Howard L. Weinshenker, George L. Greenfield, Stanley Sacks, Yount, Tarolli, Weinshenker & Cooper,* and *Wolf, Greenfield & Sacks* were on brief, for appellants.

Douglas E. Whitney, with whom *Russell & Nields, Richard S. Koppel,* and *David H. Halpert* were on brief, for appellee.

March 20, 1972

ALDRICH, *Chief Judge.* The facts in this case were briefly noted in our previous opinion under date of January 20, 1972, to which this is supplementary. After further briefing and argument we see no more likelihood of plaintiff's success today than we did then. Although plaintiff wishes to be considered as thinking of "5 Minute" merely as suggestive of speed and not specifically descriptive, its own witnesses testified that their initial intent was—as was defendant's—to find an epoxy glue that set in five minutes. When originally developed, epoxies were slow in setting, which, as plaintiff admits, "limited their utility in certain

areas, such as model-building, where many adhesive joints had to be made seriatim." Because of this, a five minute set was highly attractive, as plaintiff's great commercial success itself manifested.

This is hard evidence and not speculation. We are not impressed with plaintiff's rejoinder:

> "There being no evidence reaching the state-of-mind of the average consumer, there is nothing to rebut the magistrate's conclusion that the average consumer would see a *suggestion* but not a description." (Emphasis in orig.)*

Plaintiff overlooks a second fact, that even after its supplier developed a five minute set, a demand remained for longer setting periods, for other uses. Hence the length of the set would be uppermost in the mind of a purchaser who was making a choice. Having no right to exclude others from selling epoxies having its particular set characteristic, plaintiff may not handicap its competitors by compelling them to water down their own announcement so that plaintiff may seem to be the only one who fills the bill. *See*

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* We do not think this is an accurate interpretation of what the magistrate concluded. He said,

> "On the other hand, the average consumer seeing the phrase '5 Minute' would immediately assume that the manufacturer of the product is suggesting that the product will do a particular thing in that amount of time."

We read this as meaning that what was suggested was a particular process (*viz.*, setting) not that the length of time was merely suggestive. *Cf. Bennett* v. *McKinley*, 2 Cir., 1895, 65 F. 505 ("Instantaneous Tapioca"). Quite clearly, as plaintiff conceded during oral argument, if defendant, knowing that it took its product seven minutes to set, advertised it as "5 minute," plaintiff would make a claim for unfair competition quite apart from trademark infringement.

Our discussion of the magistrate's resolution of the evidence is without prejudice to the broad issue of its propriety, which we do not reach. We decide this case on the conceded facts, and our own conclusion as to the probability of plaintiff's success.

Bennett v. *McKinley,* ante note at 506. *See also Esquire Inc.* v. *Esquire Slipper Mfg. Co.,* 1 Cir., 1957, 243 F. 2d 540, 543. Nor can it pick a mark that would make a general request by a buyer for a five minute epoxy seem like a specific request for plaintiff's product. *See Kellogg Co.* v. *National Biscuit Co.,* 1938, 305 U. S. 111, 116-17.

Plaintiff's final argument, that intentional copying of a descriptive phrase raises a presumption that the phrase had acquired a secondary meaning, is pure bootstrap.

The preliminary injunction issued by the district court is vacated.

Order

UNITED STATES DISTRICT COURT
DISTRICT OF MASSACHUSETTS

DEVCON CORPORATION,
Plaintiff,

v.

WOODHILL CHEMICAL SALES CORPORATION and ZAYRE CORPORATION,
Defendants.

Civil Action No. 71-927-C.

CAFFREY, *J.*

Upon consideration of the filings and the Memorandum of Magistrate Davis dated December 28, 1971, the motion of the plaintiff for a preliminary injunction is granted. It is ORDERED that the defendants, their agents, servants or employees be and hereby are enjoined preliminarily from infringing the trademark "5 Minute" of plaintiff in any

manner, and from employing said trademark or any variation or portion thereof in sales promotion, literature or upon products marketed by defendants. This injunction is to remain in effect until further order of the Court.

ANDREW A. CAFFREY,
United States District Judge.

Date: Jan. 6, 1972.

Memorandum

December 28, 1971.

UNITED STATES DISTRICT COURT

DISTRICT OF MASSACHUSETTS

DEVCON CORPORATION,

Plaintiff,

v.

WOODHILL CHEMICAL SALES CORPORATION and ZAYRE CORPORATION,

Defendants.

Civil Action No. 71-927-C.

DAVIS, *M.*

This is a civil action brought under the Trademark Laws of the United States by Devcon Corporation, a Corporation organized under the laws of the Commonwealth of Massachusetts with a principal place of business in Danvers, Massachusetts, against Woodhill Chemical Sales

Corporation, an Ohio Corporation with its principal place of business in Cleveland, Ohio, and Zayre Corporation, a Delaware Corporation with its principal place of business in Natick, Massachusetts.

The complaint is in two counts and alleges trademark infringement and unfair competition by the defendants. The complaint was filed on April 23, 1971. On May 25, 1971 the defendants filed an answer and a counterclaim. Interrogatories were filed on May 25, 1971 which were answered on July 8, 1971. In July, requests for documents were filed and these documents were produced in August of 1971. On September 22, 1971 depositions were taken by the plaintiff. On November 12, 1971 the plaintiff filed a motion for a preliminary injunction. The late filing of such a motion was explained away by counsel for the plaintiff. According to counsel, prior to the filing of the motion for a preliminary injunction, repeated attempts had been made to settle the issues but these attempts were unsuccessful. The matter was then assigned to me for hearing on the motion for a preliminary injunction. After hearing I find as follows.

Devcon Corporation is engaged in the business of development and manufacturing of adhesives. Albert N. Creighton is the President of Devcon and has been in this particular business since 1947 when this company was then known as Chemical Development Corporation. In 1954 the name of the corporation was changed to its present name, Devcon. Mr. Creighton is a chemist who had worked for some time on the development of a quick setting glue. In 1967 he was successful in developing a glue which sets in five minutes. Mr. Creighton called his product "5 Minute" Epoxy. In October of 1967 this new product was featured at the National Hardware Show in New York.

At that time orders were taken for this new product. After the hardware show the number of orders for the new product became so numerous that it was difficult for Devcon to fill them.

In 1968, Devcon began an extensive advertising campaign using the phrase "5 Minute" Epoxy. Advertising included, but was not limited to such magazines as Home and Auto Retailer, Hardware Age, Hardware Retailer, Popular Mechanics, and R. C. Modeler. In connection with this advertising campaign, Devcon supplied nearly 35,000 hardware dealers with bulletins and sales display material on "5 Minute" Epoxy.

After the introduction of "5 Minute" Epoxy at the National Hardware Show, various articles were written about the new product in such magazines as Parade and Better Homes and Gardens.

Since the new sales promotion began, Devcon had repeatedly used "5 Minute" as the basis for its advertising and display materials.

After a diligent search to ascertain whether or not the words "5 minutes" would conflict with any other trademark, Devcon applied for registration of the trademark "5 Minute." There was no opposition. On February 2, 1971, the United States Patent Office granted Devcon Registration Number 906,996.

Sometime in the year 1970, Woodhill distributed an advertising circular for a new product which it called "E-Pox-E 5, Five Minute Glue." Prior to this time Woodhill had merely described its product as "E-Pox 5" or "E-Pox-E Glue." Devcon informed Woodhill of the trademark "5 Minute" and requested Woodhill to discontinue its use; however, Woodhill refused and is continuing to advertise "E-Pox-E 5" as five-minute glue.

The right to a particular mark grows out of its use, not its mere adoption; its function is simply to designate the goods as the product of a particular trader and to protect his good will against the sale of another's product as his. *United Drug Co.* v. *Theodore Rectanus Co.*, 248 U. S. 90 (1918). The legal test for a trademark infringement is the same as that of unfair competition, which is basically, the likelihood of consumer confusion as to the source of the goods. *Coca-Cola Co.* v. *Snow Crest Beverages, Inc.*, 162 F. 2d (1st Cir. 1947), cert. denied, 332 U. S. 809 (1947).

Applying this test, it is readily seen that the average consumer could confuse the two products. The phrase "5 Minute" is prominently displayed on the package of both. Additionally, both packages use the color red as background.

Devcon presented evidence showing two instances where confusion did in fact occur. As a part of a sale display, Devcon sent to hardware dealers around the country a copy of an article written in the magazine R. C. Modeler about Devcon's new "5 Minute" Epoxy. A photograph was introduced showing the use of this reprinted article together with a package of "E-Pox-E 5" which was the product of Woodhill. The other instance occurred when the firm of Dutton-Lainson Company of Hastings, Nebraska included a flyer advertising Woodhill's "E-Pox-E 5" into the folder containing flyers and information about Devcon's new product. Clearly there is confusion. Having examined the products and advertisements relating thereto, and taking into consideration the two instances cited by Devcon, I rule that there is a great likelihood of consumer confusion as to the source of the "5 Minute" Epoxy.

Woodhill presents but one argument in opposition to the plaintiff's motion for a preliminary injunction. Woodhill argues that the use of the words "5 minute" is descriptive of the product. It is, of course, well settled that descriptive words cannot be appropriated as trademarks. *Armstrong Paint and Varnish Works* v. *Nu-Enamel Corporation,* 305 U. S. 315 (1938); *American Plan Corporation* v. *State Loan and Finance Corporation,* 365 F. 2d (3rd Cir. 1966), cert. denied, 385 U. S. 1011 (1966); *Affiliated Enterprises* v. *Gruber,* 86 F. 2d 958 (1st Cir. 1936). However a mark which is descriptive of the product may become a valid trademark if it can be shown that the mark, through use, has acquired a secondary meaning. *Flexitized, Inc.* v. *National Flexitized Corporation.,* 335 F. 2d 774 (2nd Cir. 1964), cert. denied, 380 U. S. 913. Therefore, it must be determined whether or not the phrase "5 Minute" is descriptive of the product and if so, whether or not it has acquired a secondary meaning.

At the hearing, no evidence was presented which indicated that any company engaged in the manufacture and distribution of an adhesive had ever advertised a glue which sets in five minutes. As far as it can be determined, a five-minute glue was first made known to the public at the National Hardware Show in New York City in 1967. At this particular show, Devcon introduced the product and as a result, numerous orders were made for the product. During the years 1967, 1968, and 1969 there is no evidence that any other company advertised a quick setting glue as "5 Minute" Epoxy. Indeed, examination of numerous exhibits entered into evidence shows that Woodhill and other companies engaged in manufacturing and distribution of glue advertised it with words such as, "quick set", "super fast", "dries in minutes", and "clear fast set." Hav-

ing been the only manufacturer of glue advertising epoxy which sets in five minutes for a period of nearly three years, it could very well be that the consumer had associated the product with Devcon.

If that were true, the phrase "5 Minute," even though descriptive, had acquired a secondary meaning and would be entitled to protection.

Even though it could be said that "5 Minute" has acquired a secondary meaning, I am of the opinion that it is unnecessary to rule on the issue for the reason that the phrase "5 Minute" is not descriptive but suggestive. When one thinks in terms of the word descriptive, it immediately comes to mind that the word expresses a quality, kind, or condition of whatever is being described. On the other hand, when one thinks in terms of a word as being suggestive, one thinks of mental associations or one thought relating to another. It is difficult to imagine that the phrase "5 Minute" could be descriptive of a product. It certainly does not relate to the quality of the product, nor does it relate to the character. The question immediately comes to mind when considering the phrase "5 Minute" as being descriptive, just what does it describe. Does it describe the glue as setting in five minutes? Does it describe the glue as forming a permanent bond in five minutes? Or does it describe the glue as being simple to use which will work in five minutes? Thus it would seem that there are too many variables involved which would preclude one from seeing that five minutes describes the product. On the other hand, the average consumer seeing the phrase "5 Minute" would immediately assume that the manufacturer of the product is suggesting that the product will do a particular thing in that amount of time.

Moreover, in finding that the phrase "5 Minute" is suggestive rather than descriptive, great weight must be given to the fact that the Patent Office registered "5 Minute" as a trademark showing that it was considered susceptible of appropriation as a mark. *W. G. Reardon Laboratories* v. *B & B Exterminators,* 71 F. 2d 515 (4th Cir. 1934).

I therefore rule that the defendants' continued use of the words "5 Minute" is, "likely to cause confusion or mistake and to deceive the defendant's customers as to the source of origin of the goods . . . dispensed by defendant." *Tiffany & Co.* v. *Boston Club, Inc.,* 231 F. Supp. 836, 845 (D. C. Mass. 1964). If the confusion is great, the trademark granted to Devcon could be destroyed. Thus, Devcon would suffer immediate, irreparable harm.

Accordingly, I hereby recommend that the Motion for a preliminary injunction be granted.

WILLIE J. DAVIS,
United States Magistrate.